

REMARKS

In the Office Action dated October 1, 2007, Claims 3-8 and 13-17 are pending and under examination. Claims 3-6 and 14-17 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by Slaughaupt (US 2005/0204409 A1) ("the '409 publication"). Claims 7-8 are rejected under 35 U.S.C. §103 as obvious over the '409 publication. Claim 13 is rejected as allegedly obvious under 35 U.S.C. §103 over the earlier publication by Slaughaupt, US 2002/0169299 A1.

As a preliminary matter, Applicants observe that the Examiner has withdrawn the previous rejections based on US 2002/0169299 A1 by Slaughaupt. In the instant Action, the Examiner states that Applicants' arguments in the previous Response are convincing "regarding the fact that '299 application no longer includes claims directed to methods for detecting a polymorphism associated with familial dysautonomia". Therefore, the Examiner has withdrawn the rejections based on US 2002/0169299 A1 by Slaughaupt.

Applicants respectfully submit that the Examiner has mischaracterized Applicants' previous submission. For clarity of the record, Applicants previously submitted that the Examiner has not established that the '299 publication and the present application are directed to the same patentable invention. See, page 3-4 of the Response filed on July 3, 2007. In particular, Applicants noted previously that the claims in the application underlying the '299 publication, Serial No. 10/041,856, were significantly amended since the publication of the application. Applicants also stated that based on the reasoning (i.e., the Examiner's reasoning) provided in the Restriction Requirement issued in the '856 application, the claims of the present application and the claims drawn to nucleic acids presently pending in the '856 application, are not the same patentable subject matter. Therefore, on this basis, Applicants

concluded that the Examiner has not met the initial burden to establish that the '299 publication and the present application are directed to the same patentable invention. Additionally, Applicants submitted that the '856 application was not in condition for allowance at the time, and therefore it was permissible for Applicants to antedate the '299 publication based on Applicants' §131 Declaration.

Applicants reserve the right to make independent determination on whether the claims of the '856 application, now allowed, and the claims of the present application, are directed to the same patentable invention for purpose of interference.

Turning to the pending Office Action, Applicants respectfully submit that the rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103 based on the '409 publication is improper. Applicants observe that the application underlying the '409 publication, Serial No. 11/073,273, contain claims directed to methods for assaying the presence of a mutation associated with familial dysautonomia, presented in a response filed by the applicant of the '273 application on December 27, 2007. However, according to PAIR, a Final Action issued in the '273 application on March 20, 2008. Therefore, the '273 application is not in condition for allowance. According to MPEP 2305-I,

“[I]f a published application contains claims to the same invention, but the claims in the published application are not in condition for allowance, then no interference is yet possible. 37 C.F.R. 41.102. Since the claims in the published application might never be allowed in their present form, it is not appropriate to proceed as though an interference would be inevitable. Consequently, an affidavit under 37 C.F.R. §1.131 may be submitted.”

Therefore, Applicants respectfully submit that under the circumstances, it is proper and permissible for Applicants to submit a §131 Declaration and antedate the '409 publication. Because the '409 publication is based on an application which was filed as a divisional

application from Serial No. 10/041,856 (published as the '299 publication), Applicants' Declaration under 37 C.F.R. §1.131, submitted on May 10, 2005 that antedates the '299 publication, is applicable here and effectively antedates the '409 publication. Accordingly, withdrawal of the rejections based on the '409 publication is respectfully requested.

With respect to the rejection of claim 13 based on the '299 publication, it is respectfully submitted that claim 13 and claim 8 have been canceled, without prejudice, by way of the instant amendment. The rejection of claim 13 is therefore moot and withdrawal thereof is respectfully requested.

In view of the foregoing amendments and remarks, it is firmly believed that the subject application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,



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